



PATENT

Attorney Docket No.: A-68718-4/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DECLARATION OF RENEE M. KOSSLAK UNDER 37 C.F.R. § 1.47(a)

Box Missing Parts
Assistant Commissioner of Patents
Washington, DC 20231

Sir:

I, RENEE M. KOSSLAK, declare that:

1. I am the attorney who prepared the above-identified application. In this application and in this petition under 37 C.F.R. § 1.47, I am representing the interests of Clinical Micro Sensors, Inc. (Hereinafter “CMS”).
2. Upon information and belief, the subject matter of the application was conceived and developed by Gary F. Blackburn, Hau H. Duong, Piotr Grodzinski, Jon F. Kayyem, Stephen D. O’Connor, Gary T. Olsen, Robert Pietri, Robert H. Terbrueggen, and Frederic Zenhausern (the ‘inventors’). Gary F. Blackburn, Hau H. Duong, Piotr Grodzinski, Jon F. Kayyem, Gary T. Olsen, Robert Pietri, Robert H. Terbrueggen, and Frederic Zenhausern have signed the declaration for the application and assignment of the application to CMS.

3. The application was prepared based partly on utility applications U.S.S.N.

09/760,384, filed January 1, 2001, in the names of Hau H. Duong, Gary Blackburn, Jon F. Kayyem, Stephen D. O'Connor, Gary T. Olsen, Robert Pietri, and Robert H. Terbrueggen; and utility application U.S.S.N. 09/904,175, filed July 11, 2001, in the names of Hau H. Duong, Gary Blackburn, Jon F. Kayyem, Stephen D. O'Connor, Gary T. Olsen, Robert Pietri, Nathan Swami and Robert H. Terbrueggen. As both of these utility applications were device oriented applications, they were prepared with the assistance (including scientific input and/or data) of Stephen D. O'Connor and he signed the Declaration and Assignment for both applications.

4. On February 13 1999 Stephen D. O'Connor terminated his status as an employee of CMS.

5. After receiving the Notice to File Missing Parts, a letter was sent by me to CMS on June 28, 2002 requesting that the declaration and assignment be signed and dated by each inventor. A copy of the letter requesting that the declaration and assignment be signed and dated is attached as Exhibit 1.

6. On July 8, 2002 Stephen D. O'Connor notified me, via telephone, that he did not want to review the present application as it contained subject matter on microfluidics. In a separately placed phone call, Stephen O'Connor also notified Robin M. Silva, the partner in charge of this case, that he did not want to review the present application.

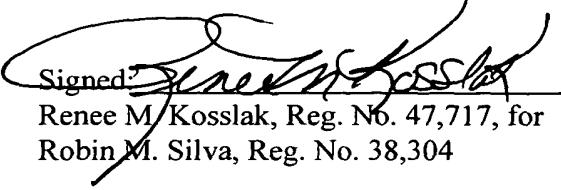
7. On July 8, 2002 Stephen D. O'Connor was notified, via facsimile, that if he did not want to review or receive confidential CMS information, including the pending application, that this would be interpreted as an express refusal to sign the

“Declaration for Patent Application”. A copy of the facsimile is attached as Exhibit 2.

8. On July 8, 2002 Stephen D. O'Connor, via facsimile, confirmed in writing his refusal to sign the “Declaration for Patent Application”. A copy of this facsimile is attached as Exhibit 3.
9. Accordingly, as required by 37 C.F.R. §1.47 and M.P.E.P. §409.03(d), the applicants have met the requirements for proving a refusal to sign the declaration and assignment.
10. Stephen D. O'Connor is obligated by agreement with CMS to assign his entire interest in the subject matter of the application to CMS. A copy of the Agreement executed by Stephen D. O'Connor when he joined CMS is attached as Exhibit 4. Section 2(b) of the Agreement requires the assignment of all inventions made by the employee in the course of her employment. Section 2(e) of the Agreement requires that the employee assist the Company in obtaining patent rights covering all inventions and original works of authorship assigned to the Company and that this obligation shall continue beyond termination of employment.
11. In accordance with the employment agreement, Section 2(e), Jon F. Kayyem President and CEO, an officer of CMS who is authorized to act on CMS's behalf, has signed the assignment on Stephen D. O'Connor's behalf.
11. Stephen D. O'Connor currently resides at 1892 Galbraith Road, Pasadena, California 91104.
12. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. All statements made

by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Dated: 7/8/02, 2002

Signed: 
Renee M. Kossak, Reg. No. 47,717, for
Robin M. Silva, Reg. No. 38,304

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